

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Application No. **09/834,208**

Confirmation No. 3950

Filing Date : April 13, 2001

Examiner: M. Mendoza

Appellant: G. Thomas Wolf

Art Unit: 3731

For: **Oxygen Mask**

Docket No. 0022.010001

REPLY BRIEF TO EXAMINER'S ANSWER

Mail Stop: APPEAL BRIEF - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer mailed August 6, 2008, Appellant submits the following Remarks.

The Appeal Brief is presented in the following format:

- (A) Identification page setting forth the Appellant's name(s), the application number, the filing date of the application, the title of the invention, the name of the examiner, the art unit of the examiner and the title of the paper (i.e., Appeal Brief);
- (B) Status of claims page(s);
- (C) Grounds of rejection to be reviewed on appeal; and
- (D) Argument page(s).

Remarks

Appellant hereby offers the following remarks.

(B) STATUS OF CLAIMS

Claims 5-10, 12-15, 17, and 18 are on appeal, with claims 5, 8 and 14 being independent claims. Claims 1-4 were originally filed. Claims 5-10 were added in the amendment filed February 8, 2004, claims 11-13 were added in the amendment filed July 19, 2004 and claims 14-18 were added in the amendment filed June 29, 2005. Claim 4 was cancelled in the amendment filed February 8, 2004, claims 1-3 and 11 were cancelled in the amendment filed June 29, 2005 and claim 16 was cancelled in the amendment filed on June 16, 2006.

(C) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL:

Claims 5-10 and 12-14¹ stand finally rejected under 35 U.S.C. 103(a) as unpatentable over Hudson (US Patent No. 2,843,121 taken in view of Bledstein (US Patent No. 5,701,892).

Claims 12, 13, and 18 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hudson (US Patent No. 2,843,121 taken in view of Bledstein (US Patent 5,701,892), as applied to the claims 5-10 and 12-14 when taken in further view of Laanen et al. (US Patent No. 4,865,027).

(D) APPELLANT'S ARGUMENTS:

The Rejection of the claims under 35 U.S.C. 103(a):

The Examiner repeated his rejection as set forth in the Final Rejection mailed January 22, 2008.

Claims 5-10 and 12-14 stand rejected by the Examiner² as being unpatentable over Hudson (US Patent No. 2,843,121) in view of Bledstein (US Patent No. 5,701,892); and as

applied to the claims 5-10 and 12-14 when taken in further view of Laanen et al. (U.S. Patent No. 4,865,027).

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hudson/Bledstein in further view of Dyrud et al. (U.S. Patent no 5,829,731).

The Examiner acknowledges that Hudson “fails to teach a pair of bands extendible to loop over and around each ear of the patient.”

Regarding Claims 6 and 9, the Examiner relies on Bledstein as teaching “a mask that uses a pair of bands affixed at four points of attachment and extendible to loop over and around each ear of a patient.”

As to claim 15, the Examiner urges that “Hudson/Bledstein teaches the oxygen mask of claim 14, wherein both ends of the straps is adjustably connected to the face mask (col. 2, lines 20-31),” (Final Rejection, page 7, paragraph 12).

As to claim 17, the Examiner stated that “Hudson/Bledstein teaches the oxygen mask of claim 14, which additionally comprises an adapter plug 23.” (Final Rejection, page 7, paragraph 13).

As to claims 12, 13 and 18 the Examiner stated that Laanen et al. teaches a valve to allow exhaled air to be forced out to the atmosphere.

As to claim 16, the Examiner stated that Dyrud teaches a mask with “a common one end of each strap is adjustable connected to a face mask, and the second end of each strap is permanently attached.”¹

¹ While not specifically addressed in the statement of rejection in the Final Rejection of January 22, 2007, claims 15 and 17 were addressed in the explanation of the rejection. Therefore, the present discussion includes arguments relating to these claims, in addition to those specifically rejected.

² Final Rejection of January 22, 2007.

The Examiner concludes that “it would have been obvious to one of ordinary skill in the art at the time of invention was made to replace band 17 (of Hudson) with ear loops of Bledstein to prevent entanglement of bands in a user’s hair, glasses, or hat and to make it easy to put on (col. 2, lines 32-33 and col. 6, lines 10-17).” (Final Rejection, pages 4-7).

Appellant, respectfully, disagrees and incorporates the remarks from the Appeal Brief.

Appellant continues to assert that the Examiner has not met his burden within the meaning of 35 U.S.C. 103(a) and that for the reasons provided below the rejection should not be sustained on appeal.

To summarize, Claim 5 is directed to an oxygen mask comprising the following components:

- 1) an oxygen mask
- 2) a pair of elastic bands
- 3) both ends of each band is affixed at points of attachment on each side of the oxygen mask
- 4) both bands are extendible to loop over the ears
- 5) each band is adjustable by pulling the ends anteriorally through the point of attachment.

Claim 6 depends on claim 5 and further provides that the elastic bands are affixed at 4 separate points on the mask. Claim 7 is similar, but provides that the elastic bands are affixed at 2 separate points on the mask. Claim 8, 9 and 10 are similar in scope and limitations to claims 5-7, respectively. Claim 14 is similar to claim 5 but includes more detail about the nature and structure of the mask portion. Claim 15 depends from claim 14 and provides that both ends of the elastic bands are to be adjustable. Claim 17, similarly, depends from claim 14 and provides

for the presence of an adapter plug to permit connection to the mask of an oxygen reservoir bag, air entrainment device or a nebulizer. However, given their dependency on claim 14, each requires the same elements of the attachment and adjustment of the elastic bands to the mask portion.

The sum of the Appellant's arguments is the following:

1. **Hudson does not teach a pairs of bands.** Hudson does not describe a pair of elastic bands and therefore can not disclose or describe the attachment of such a pair of bands to the sides of tan oxygen mask and there is no mention of looping the pair of bands over the ears of a patient.
2. **Hudson teaches away from the invention.** Hudson only has *one* of elastic band and does not disclose *a pair* of elastic bands on each side, as required by the claims. Hudson states that the comfortable wearing position is "just below the ears." (Col. 2, lines 36-38) There is *nothing* in Hudson which would suggest the need to use any other type of system to hold the oxygen mask on the patient in need of oxygen treatment. Additionally, the '121 patent teaches away from the invention ,wherein the strap of the mask "can readily be moved only by pinching the strap together adjacent the opening, forcing it into a relatively rounded shape and then pulling it." (col. 2, lines 30-32) The act of rounding the strap to force it through a round hole then pulling the strap would require the use of two hands, and unnecessary movement of the patient, particularly in emergency response services . The strap of the '121 patent are not moved by simply pulling anteriorally on the strap, as claimed herein, but by pinching the straps to make them round, then pulling on them, especially as claim 3 of the '121 patent requires a flat strap and a round hole (see Figures 4 and 6).
3. **Bledstein is non-analogous art.** No where in Bledstein is there any reference to the use of the mask with a "patient" as would be appropriate for the currently claimed oxygen mask.

Clearly the disclosed mask is a filtration system and would not serve as an oxygen mask as presently claimed.

4. **Bledstein also teaches away from the invention.** The motivation provided by the Examiner, to avoid entanglement I a user's hair, and so forth, ignores Bledstein's *explicit* motivation to adjust the mask by means of a cord stop (col. 6, lines 10-19). Clearly this system differs from the presently claimed invention in that the elastic or cord material of Bledstein is permanently attached to the mask.

5. **Dyrud teaches away from the invention.** Dyrud provides a *single strap* which releases from behind the ears of the wearer, and only when the band is pulled from behind the ears is the strap *released*; presenting a totally different mechanism of attachment, and also, as in Bledstein, the adjustment is to *release* the mask, not tighten it as in the present invention. (col 3, line 59 and bridging over to col. 4, line 4).

6. **The combination of the strap system of Bledstein for the single strap of Hudson, would not reveal the present invention.** In both situations described, adjustment is of a method which does not involve "pulling the ends anteriorally through the point of attachment," as required in the claims. Even if one were to substitute the strap system of Bledstein for the single strap system of Hudson one would not arrive at the presently claimed invention. The straps would be permanently attached to the mask, not adjustable by "pulling the ends anteriorally through the point of attachment" as required by claim 5, as well as claims 6-10 and 14 which include the same limitation. No where in Hudson, does the reference state or describe the adjustment of the fit of the disclosed mask using a pull through technique as presently claimed. The only disclosure relating to the single strap of the device, is that Hudson regarded the strap as a *release*

mechanism for removing the mask in question. Specifically, Hudson is describing the attachment means states (Col. 2, lines 28-32)

Thus, neither Hudson, which only includes a single strap, nor Bledstein, which disclosed two bands, but requires a fixed means of attachment with a differing system for adjustment meant to *loosen the mask*, address these claim limitations in a manner which would reasonably support a conclusion of obviousness under 35 U.S.C. 103(a).

7. **The M.P.E.P. states that the combination of the art must not change the principle of operation of the invention.** MPEP 2143.01 states that, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. The combination of Hudson and Bledstein would change the operation of the present invention.

8. **The Examiner has failed to establish a *prima facie* position of obviousness.** The Appellant would urge that the Examiner failed to establish a *prima facie* case of obviousness within the meaning of 35 U.S.C. 103(a). In a rejection under 35 USC § 103(a), the Examiner bears the initial burden of establishing a *prima facie* case of obviousness for the reasons stated herein. To the extent that the Examiner urges that the use of the straps of Bledstein would “prevent entanglement of bands in a user’s hair, glasses, or hat and make it easier to put on” Appellant would urge that these considerations or purposes have not been shown to be applicable to the oxygen mask of the present invention or that of Hudson. These are aesthetic issues and of little importance when dealing with a situation which suggests the need of an oxygen mask.

9. **The Examiner has used impermissible hindsight reconstruction to arrive at the present invention.** Clearly, the present rejection represents a picking and choosing of elements from of

two references, with a disregard as to those elements of the disclosure of each which might suggest that the combination is inappropriate. In other words, “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). There is nothing in this record which would readily suggest the combination of these two teachings other than appellant’s own disclosure of the invention.

10. **The Examiner has not taught each and every limitation of the claims.** In putting together the reasoning and evidence in support of this rejection the Examiner has failed to account for each and every claim limitation of the present claims. Specifically, the limitation of claim 5 and particularly those limitations noted as to claim 14 have not been accounted for. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (See also, MPEP, section 2146.03).

11. **The Examiner has not addressed Claims 12 and 13.** It is noted that claims 12 and 13 are grouped with the present rejected claims. However, the Examiner has not addressed these claims in setting forth the basis for rejection. Since these claims include, and thus require, limitations not present in either Hudson or Bledstein, as acknowledged in the following rejection under 35 U.S.C. 103(a), it follows that these claims are improperly rejected under 35 U.S.C. 103(a) over the combination of these two references.

12. **The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103 and KSR.** Lastly, Appellant respectfully directs attention to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since

the Supreme Court in *KSR Int'l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between the claimed invention and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added).

13. The Board of Patent Appeals and Interferences recently reversed a § 103 rejection

because the Examiner did not explain the source of all of the features of the claimed invention. A January 2008 BPAI decision entitled, *Ex Parte Wada and Murphy* (Appeal 2007-3733, January 14, 2008) reversed a § 103 rejection because the Examiner did not explain where or how cited art taught or suggested all of the features of a claimed invention. Of particular interest is the following BPAI articulation of applicable law:

When determining whether a claim is obvious, an examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). (emphasis in original).

Thus, appellant would urge that the present rejections of the claims fail to provide that level of evidence which would reasonably support a conclusion that the presently claimed invention would have been obvious within the meaning of 35 U.S.C. 103(a). Therefore, Appellant requests that all grounds for rejection be reversed.

Conclusion

Claims 5-10, 12-15, 17 and 18 are under consideration by the Examiner. The Appellant respectfully requests favorable consideration of the application in view of the Appeal Brief filed on October 26, 2007 and the present Reply Brief. In view of the above remarks, Appellant respectfully submits that the application and claims are in condition for allowance.

Prompt and favorable consideration of this Reply Brief is respectfully requested.

Respectfully submitted,

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Date: October 6, 2008

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